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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/734,949 | 12/12/2000 | Christopher Jacques Penrose Barton | SHZ-106 | 3435 |

27774 7590 03/25/2005

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| EXAMINER | |
|---|---|
| NGUYEN, CUONG H | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3661 | |

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/734,949 | BARTON ET AL. | |
| | Examiner | Art Unit | |
| | CUONG H. NGUYEN | 3661 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *11 January 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-40 and 54-57* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) *1-40 and 54-57* is/are allowed.

6)☒ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

## DETAILED ACTION

1. This Office Action is the answer to a response received on 1/11/2005, which paper has been placed of record.

2. Claims 1-40, 54-57 are pending in this application; claims 41-53, and 58-60 were canceled on 1/11/2005.

### Response

3. The arguments submitted on 1/15/05 are unpersuasive. The decision of 35 USC 101 panel's representative on technological art affirmed on 3/10/2005 that pending claims are non-statutory (according to claimed language, a sample can be anything, e.g., a written essay, a received paper with a recorded wave chart etc.). The examiner regrets for a typo error on 35 USC 102 mailed on 10/12/2004 (in the Office Action, it should be read as 35 U.S.C. 102(a) rejections instead of 35 USC 102(e) rejections on line 11 of page 6). On page 10, line 10 of the response (1/11/05), the applicants argue that "Bond fails to disclose "a sample of an experiential environment""; the examiner respectfully submits it reads on a music sample/song of Bond (please note that the pending claim does not define about "an experiential environment" to make it distinguish from Bond; therefore, that environment could cover a musical environment or a transaction environment.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

> **Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.**

4. Independent claims **1, 25, 28, 31, 34, 54-55** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A. As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave,* 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

B. Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr,* 450, U.S. 175, 185, 209 USPQ (BNA) 1,7 (1981}. However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

C. This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences(BPAI}. See *In re Toma,* 197 USPQ (BNA) 852 (CCPA 1978). In *Toma,* the court held that the recited mathematical algorithm did not render the claim as a whole non statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson,* 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

> The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is

> statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

D. In *Toma,* the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

E. The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.,* the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co. at* 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[whether the patent's claims are too broad to be patentable is not to be judged under §101,

but rather under §§102, 103 and 112." See *State Street Bank & Trust Co. at* 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, State Street abolished the Freeman-Walter-Abele test used in Toma. However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in Toma because the invention in State Street (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the Toma test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See Ex parte Bowman, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

F. In the present application, the claimed steps of the above claims indicate that this "interacting" is an electronic environment nor that it is expressly performing the actions in ~~that particular environment, e.g. claimed steps are done~~ manually. In order to place the above claims within statutory subject matter, it is suggested that the Applicants amend the claims to more clearly define claimed steps are being performed by technology, such as computer processors, electronic

communication networks, etc.

G. For instance, these claimed steps do not require "technological art":

a) Per independent claim 1: "receiving from the user a captured sample of an experiential environment" – e.g., manually receiving a song written on a paper/a recorded wave chart.

b) Per independent claim 25: "providing a user with an ability to capture a sample of an experiential environment" – e.g., manually providing a pen, and a paper to record/copy a song or to copy a wave chart.

c) Per independent claim 28: "capturing a sample of an experiential environment" – e.g., manually record/copy a song or a wave chart.

d) Per independent claim 31: "receiving a sample of an experiential environment from the user" – e.g., manually receiving a song/a wave chart written on a paper.

e) Per independent claim 34: "forwarding the sample to an interactive service to trigger a predetermined event" – e.g., give/hand-in a recorded tape to a store for sale.

f) Per independent claim 54: "capturing a user's sample of an experiential environment" – e.g., manually record/copy a song/wave-chart.

g) Per independent claim 55: "receiving a user's sample of an experiential environment" – e.g., manually receiving a song/wave-chart written on a paper.

All dependent claims are objected for dependencies.

***Claim Rejections - 35 USC § 102***

35 U.S.C. 102. Conditions for patentability; novelty and loss of right to patent.
A person shall be entitled to a patent unless -
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-8, 12, 15-21, 24-25, 28-37, and 54-56 are rejected under 35 U.S.C. 102(a) as being anticipated by Paul Bond's

**article "A star is born nationally seeking stellar CD sales".**

a. Per claims 1-8, 15, 24, 28, 31-32, 34, and 54-55: Bond teaches a method for interacting with a user for entertainment comprising:

- receiving from the user a captured sample of an experiential environment; and triggering a predetermined transaction in response to the captured sample. Bond teaches about transmitting/forwarding a song by telephone line, then Bond also provides/"triggers" the user with purchasing that song (see Bond, 3rd para. wherein Bond teaches about a sale for CDs).

Bond's article also teaches about determining from the signal a characteristic of the captured sample and triggering a transaction in response to the determined characteristic (i.e., artist's name - related information about this sample are exchange from this interactive communication). Bond teaches about an offer for sale (see Bond, 2nd-3rd para., Bond's article teaches a user to transmit/receive a song over a telephone line; and providing a choice of making purchase - based on song's title/artist -- in response to receiving that song. -- A interactive transaction/communication for sale of the CDs is established).

b. Per claims 12, 20-21, 29, and 35: Bond teaches a method for interacting with a user comprising:

- an inherent exchange/delivery/communication of information about a transaction between a sale source and the user attendant about a sale of goods to the user (Bond inherently allows a customer to buy CDs through an attendant, see Bond, 3rd para.)

c. Per claims 17, 33: Bond teaches a method for interacting with a user for entertainment comprising:

- the predetermined event includes a monitoring/surveillance event (see Bond, 2nd -5th para., Bond teaches about providing a user with information regarding a song from a user's captured/monitoring sample).

d. Per claim 18: Bond inherently teaches a method for interacting with a user for entertainment comprising:

- a predetermined event includes a human ability enhancement event - in another word, this is related to a user's capturing a music sample.

e. Per claim 19: Bond teaches a method for interacting with a user for entertainment comprising:

- a predetermined event includes an execution of tasks - in another word, this is related to sales and purchases of songs).

f. Per claims 25-27, 30, and 36: Bond teaches a method for interacting with a user for entertainment comprising:

- providing a user to capture a song; and delivering said sample to an interactive service to trigger predetermined events (those

predetermined events are an interactive communication event, a monitoring/surveillance event - see Bond, 2nd-3rd para.).

g. Per claims 37: Bond also teaches of deriving information from the sample (i.e., identifying a name of the song, name(s) of the artist .etc).

h. Per claims 56: Bond also inherently teaches of a transactional event includes storing a captured sample by sending and retrieval said stored sample.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims **9-11, 13-14, 22-23, and 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Paul Bond "A star is born ..."**, in view of **Arent** (US Pat. 6,018,724).

The rationales and reference for rejection of claim 3 are incorporated.

a. Per claims 9-10: Bond teaches a method for interacting with a user for listening and ordering to download a music sample/song.

Bond teaches about downloading goods to a customer's device (see Bond, 5th para., Bond's article teaches a user to receive a

song over a telephone line).

Bond does not disclose about "the transaction includes delivery of advertising or promotional offers". Bond allows radio listeners to identify and purchase (sample) music over a radio broadcast.

However, Arent suggests a method of selling goods online; wherein that method suggests about delivery of promotional offers including trial/discounted offers (see Arent, 17:48 to 18:7).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Bond and Arent for including a promotional/discounted offer to Bond's selling CDs online because this is a well-known tactic in business to offer a lower price - for a short duration - compared to a regular (higher) price for drawing more customers to that store/business.

b. Per claims 13-14: Bond teaches a method for interacting with a user for listening and ordering to download a music sample/song.

Bond does not disclose about an offer is selected in response to a profile of a user.

However, Arent suggests that a user's profile/history would be used in a transaction corresponding to an offer (see Arent,

11:27-65).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Bond and Arent for including the use of personal profile to Bond's selling CDs online because this is value-able information to build a history of purchaser for knowing user's preferable style in order to serve exactly what a customer's need according to recorded information.

c. Per claims 22-23: Bond teaches a method for interacting with a user for listening and ordering to download a music sample/song.

Bond teaches about an interactive environment including a communication event.

Bond does not disclose about a predetermined event includes a control event.

However, Arent suggests about trial offer (a control event).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Bond and Arent for including the use of a communication event and a control event because Bond's transaction already covers a communication event; a trial offer (a control event) in a limited time would be beneficial to both a buyer and a seller for attracting more

customers to a business of ordering music online.

d. Per claim 38: Bond teaches a method for interacting with a user for listening and ordering to download a music sample/song.

Bond does not disclose about combining information derived from the sample with information known about the user to trigger a predetermined event.

However, Arent suggests to use a user's profile/history.

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Bond and Arent for including the use of available information to trigger a transaction because those personal information would be helpful to identify a user current need and increase a degree of accuracy in online transactions.

e. Per claims 39-40: Bond teaches a method for interacting with a user for listening and ordering to download a music sample/song.

Bond also teaches about a predetermined event includes: delivery of information to the user (i.e., downloading a song to the user).

It would have been obvious to one of ordinary skill in the art at the time of invention that Bond's teachings also give suggestions that triggered events may include: transaction-oriented event/entertainment events/events associated with

enhancements to human ability (as analysis above) because all these events provide closer information to activate a transaction of Bond and Arent.

**7. Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paul Bond "A star is born …".**

Bond teaches a method for interacting with a user for listening and ordering to download a music sample/song.

Bond does not disclose about a sorting feature for a sample.

However, the examiner respectfully submits that a sorting feature for a computer document/database is old and well-known application (based on a dominant characteristic of a captured sample, e.g., sorting data by name of artists, or sorting data in alphabetical order etc.).

It would have been obvious to one of ordinary skill in the art at the time of invention that Bond's teachings also apply a sorting feature according to a dominant characteristic of a captured sample because this help a user to organize obtained information according to a wanted feature.

**Conclusion**

8. Claims 1-40, 54-57 are not patentable. The submitted response is unpersuasive, accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicants are reminded of the

extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Remark**: Please note that Gokcen et al., (US Pat. 5,125,024) is also read on pending claims.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose number is 703-305-4553. The examiner can normally be reached on 7:15am-3:45 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THOMAS G. BLACK can be reached on 703-305-8233. The fax phone number for the organization where this application is assigned is 703-305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

Cuonghnguyen

CUONG H. NGUYEN
Primary Examiner
Art Unit 3661